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1636

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Goldberg

Application No.: 10/009,874

Filed: 12/11/2001

Title: Gene and Protein Sequences of Phage
T4 Gene 35

Attorney Docket No.: NANF.P-007

Group Art Unit: 1636

Examiner: S. Kaushal

Confirmation No.: 4607

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Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the restriction requirement mailed August 8, 2003 for the above-captioned application, Applicants hereby elect the claims of Group I, namely claims 1-4, 7-24, and 46-47 **with traverse**. The reason for the restriction is the Examiner's assertion that the proteins of Group I and the corresponding nucleic acids sequences of Group II lack unity of invention under PCT Rule 13.1. This assertion is directly contradictory to the PCT Administrative Instructions, and in particular to Example 17. Copies of the relevant pages from the MPEP Appendix are attached.

I hereby certify that this paper and any attachments named herein are being deposited with the US Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 2, 2003.

Lori South

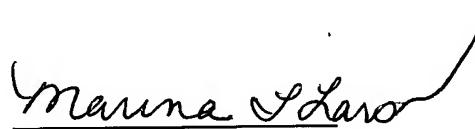
Lori South

9-2-2003

Date of Signature

In view of the fact that the Examiner's reasons for restriction are inconsistent with established and published rules relating to Unity of Invention, Applicant submits that the restriction requirement should be withdrawn and all claims considered in this application.

Respectfully submitted,



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MANUAL OF PATENT EXAMINING PROCEDURE

Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is features A + B.

Example 13

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.

Example 14

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Example 16

Claim 1: An insecticide composition comprising compound A (consisting of a₁, a₂...) and a carrier.

Claim 2: Compound a₁.

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided a₁ has the insecticidal activity which is also the special technical feature for compound A in claim 1.

Example 17

Claim 1: Protein X

Claim 2: DNA sequence encoding protein X.

ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

III. MARKUSH PRACTICE

Example 18— common structure:

Claim 1: A compound of the formula:

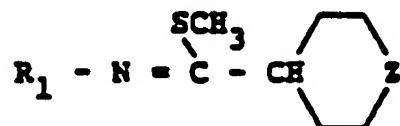


wherein R¹ is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; R²-R⁴ are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

Example 19— common structure:

Claim 1: A compound of the formula:



wherein R₁ is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene (-CH₂-). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group -N=C-SCH₃ linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

Example 20— common structure

Claim 1: A compound of the formula:

